

Amendment and Response

Applicant(s): HANSON et al.
Serial No.: 09/814,252
Confirm. No.: 6198
Filed: 21 March 2001
For: PRIMERS FOR USE IN DETECTING BETA-LACTAMASES

Remarks

The Office Action mailed 30 April 2004 has been received and reviewed. Claims 17 and 56 having been amended, and claims 38 and 57 having been canceled, the pending claims are claims 11, 17, and 56, with claim 17 currently withdrawn from consideration by the Examiner.

Reconsideration and withdrawal of the rejections herein, in view of the above amendments and the following comments, are respectfully requested.

Office Action Summary

The Office Action Summary (Form PTO-326) indicates that this is a FINAL Office Action. However, at page 2, paragraph 1 of the present Office Action, under "Detailed Action," the Examiner specifically states that "the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114." Furthermore, the USPTO PAIR system also indicates that this Office Action is NONFINAL (Appendix A). Thus, it is our understanding that the indication on the Office Action Summary that the present Office Action is a Final Action Summary was made in error. This Amendment and Response, therefore, is being submitted with the understanding that the Office Action mailed 30 April 2004 was a NONFINAL Office Action.

Additionally, Applicants respectfully request that the Examiner affirm in writing in the next Official Communication that the Office Action dated 30 April 2004 is a Non-final Office Action.

Allowed Claims

Applicants thank the Examiner for indicating that claim 11 is allowable.

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Request for Rejoinder

In the Response to Restriction Requirement filed in the present application on 17 December 2002, Applicants elected, with traverse, pursuant to the Examiner's request for an election of species, the following primer pair:

5' - CTC GAT GAT GCG TGC TTC GC - 3' (SEQ ID NO:32) and

5' - GCG ACT GTG ATG TAT AAA CG - 3' (SEQ ID NO:33).

Applicants respectfully assert that claim 17, as amended herein, encompasses the elected species, the primer pair SEQ ID No. 32 and SEQ ID NO. 33. Rejoinder of claim 17, as amended is respectfully requested.

Claim Objections

The Examiner objected to claim 56, alleging the informality that the phrase "Gram Negative organisms" should be "Gram Native bacteria." Applicants respectfully submit that the Examiner made a typographical error and intended to indicate that the claim should include the phrase "Gram Negative bacteria."

In view of the amendment to claim 56 made herein, Applicants respectfully request reconsideration and withdrawal of this objection.

The 35 U.S.C. §112, First Paragraph, Rejection

The Examiner rejected claims 56 and 57 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner asserts that the specification provides adequate written description for "Gram Negative bacteria," but not for "Gram Negative organisms." Applicants respectfully point out that the cancellation of claim 57 renders the rejection of claim 57 under 35 U.S.C. §112, first paragraph, moot.

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Applicants disagree with the Examiner regarding the above rejection of claim 56. However, solely to further prosecution of this application, Applicants have amended claim 56 to recite the phrase, "Gram negative bacteria." Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

The 35 U.S.C. §103 Rejection

The Examiner rejected claim 56 under 35 U.S.C. §103(a) as being unpatentable over Sandvang et al., (FEMS Microbiology Letters, 157:177-181 (1997)) in view of Fluit et al. (WO 91/08305).

The Examiner rejected claim 56 under 35 U.S.C. §103(a) as being unpatentable over Arlet et al., (FEMS Microbiology Letters, 82:19-26 (1991)) in view of Fluit et al. (WO 91/08305).

Although Applicants disagree with the above rejections, claim 56 has been amended herein solely to further prosecution of the present application. As neither Sandvang et al. nor Fluit et al. teach or suggest Applicants primers indicated as SEQ ID NO. 32 and SEQ ID NO. 33, it is asserted that claim 56, as amended, is nonobvious over the cited art. For at least this reason, reconsideration and withdrawal of the above rejections under 35 U.S.C. §103(a) are respectfully requested.

Claim 17

Additionally, as neither Sandvang et al. nor Fluit et al. teach or suggest Applicants primers indicated as SEQ ID NO. 32 and SEQ ID NO. 33, Applicants assert that claim 17 as amended, for which Applicants have requested rejoinder herein, is also nonobvious over the cited art.

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Summary

It is respectfully submitted that the pending claims 11, 17, and 56 are in condition for allowance and notification to that effect is respectfully requested.

The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for

HANSON et al.

By

Mueting, Raasch & Gebhardt, P.A.

P.O. Box 581415

Minneapolis, MN 55458-1415

Phone: (612) 305-1220

Facsimile: (612) 305-1228

Customer Number 26813

Sept 30, 2004
Date

By:

Ann M. Mueting

Reg. No. 33,977

Direct Dial (612)305-1217

CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to [Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this

30th day of September, 2004, at 4:40 pm (Central Time).

By:

Name:

KATHLEEN L. PDA, KLO